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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,260	01/19/2004	William C. Boyd	58372US004	6913

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/759,260

**Applicant(s)**

BOYD, WILLIAM C.

**Examiner**

Christopher P. Bruenjes

**Art Unit**

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 and 31-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 200641012
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Terminal Disclaimer***

1. The terminal disclaimer filed on January 27, 2006 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of application number 10/350,431 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Election/Restrictions***

2. Newly amended claims 1-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The originally claimed invention and the newly amended claimed inventions are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as previously claimed could be used in a materially different process of using that product such as applying the retroreflective sleeve to new

Art Unit: 1772

traffic devices that either do not have any color standard or reflectivity standard or to a new traffic device that does have a color standard or reflectivity standard but the sleeve is added to enhance the standard or provide a different standard than the original production standard.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-26 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

**WITHDRAWN REJECTIONS**

3. The double patenting rejections of claims 1-30 over claims 1-20 in application number 10/350,431 of record in the Office Action mailed November 14, 2005, Pages 3-4 Paragraph 3, have been withdrawn due to Applicant's filing of the terminal disclaimer on January 27, 2006.

4. The 35 U.S.C. 112 rejections of claims 4-11 of record in the Office Action mailed November 14, 2005, Pages 4-5 Paragraph 4, have been withdrawn due to Applicant's amendments in the Paper filed January 27, 2006.

5. The 35 U.S.C. 102 and 103 rejections of claims 1-26 of record in the Office Action mailed November 14, 2005 have been withdrawn due to Applicant's amendments in the Paper filed January 27, 2006 to a different invention that has been withdrawn due to original presentation for the reasons shown above.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 is dependent on a withdrawn claim and therefore is rendered vague and indefinite, because it is not certain what the limitations claim 30 is dependent on.

***Claim Rejections - 35 USC § 102***

Art Unit: 1772

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 30 is rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (GB 2245742).

Freeman anticipates a roll-up or flexible sign (p.1, 1.6-7). The sign comprises a reflective sleeve for application to a support (see abstract). The sleeve comprises a flexible substrate (reference number 1, Figure 1) having a viewing surface and a non-viewing surface and at least one reflective band (reference numbers 2-4 combined, Figure 1) bonded to a flexible substrate wherein a portion of the flexible substrate is exposed on the viewing surface such as the middle stripe on Figure 2.

***ANSWERS TO APPLICANT'S ARGUMENTS***

10. Applicant's arguments regarding the double patenting rejections, 35 U.S.C. 112 rejections, and 35 U.S.C. 102 and 103 rejections of claims 1-26 have been considered but are moot since the rejections have been withdrawn.

Art Unit: 1772

11. Applicant's arguments regarding the 35 U.S.C. 102 rejection of claim 30 as anticipated by Freeman have been fully considered but they are not persuasive.

In response to Applicant's argument that claim 30 is claiming a method of use and does not meet the functional/intended use limitations of claim 1, claim 30 is still an article claim since the preamble is "a roll-up sign comprising". Therefore, in determining the broadest reasonable interpretation of claim 30, the structural limitations in claim 1 are given full patentable weight and the functional limitations are given little patentable weight. In this case, Freeman teaches all of the structural limitations of claim 30 and claim 1, and has the ability to perform the functional limitation of claim 1. Thus, Freeman anticipates claim 30.

#### **Conclusion**

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this

Art Unit: 1772

action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB *CPB*  
February 21, 2006

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

*2/22/06*